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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,719	01/18/2001	Hiroshi Inoue	35.C15061	5427
5514	7590	11/01/2004	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			CHEUNG, MARY DA ZHI WANG	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/761,719	INOUE ET AL.
Examiner	Art Unit	
Mary Cheung	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 18 January 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-59 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 3/9/01;10/18/01;7/9/03

- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the application filed on January 18, 2001. Claims 1-59 are pending. Claims 1-59 are examined.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 9-12, 18-21, 29-32, 38-41, 43, 45, 47, 49, 53-54 and 59 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 9-12, 18-21, 29-32, 38-41 and 53-54, it is not clear what the “IPMPS\_Type”, “IPMP\_Descriptor IPMP Message”, and “MPEG-4 IS v.1” refer to. How do they relate to the IPMP System.

Claims 43, 45 47, 49 and 59 are dependent claims, and recite “A storage medium comprising program codes stored thereon, ...”. However, their independent claims are method claims. The applicant is advised rewrite these dependent claims into method claims.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4, 6, 13-15, 22-24, 26, 33-35, 42-50 and 58-59 are rejected under 35 U.S.C. 102(b) as being anticipated by Ginter et al., U. S. Patent 5,892,900.

As to claims 1, 3, 22, 42 and 46, Ginter teaches a digital contents distribution system and method having a client, a digital contents server, a roaming server, and a network connected between the client, the digital contents server, and the roaming server (column 53 line 39 – column 54 line 32 and column 55 lines 6-29 and Figs. 1, 2, 78-80),

- a) wherein said roaming server comprises means for receiving from the digital contents server a digital content with an intellectual property right protection system protecting the digital content (column 56 lines 6-18 and Figs. 1, 2, 78-80),
- b) means for converting the intellectual property right protection system of the received digital content into another kind of intellectual property right protection system (column 56 lines 18-24 and column 326 lines 27-48 and Figs. 1, 2, 78-80),
- c) means for delivering to said client the converted system (column 56 lines 25-29 and column 326 lines 27-48 and Figs. 1, 2, 79-80).

As to claims 13, 15, 33, 44 and 48, Ginter teaches a digital contents distribution system and method having a client, a roaming server, and a network connected between the client and the roaming server (column 53 line 39 – column 54 line 32 and column 55 lines 6-29 and Figs. 1, 2, 79-80),

- a) wherein said roaming server comprises means for receiving from said client a digital content with an intellectual property right protection system protecting the digital content (column 311 line 30 – column 312 line 32 and Fig. 78),
- b) means for converting the intellectual property right protection system of the received digital content into another kind of intellectual property right protection system (column 318 lines 30-58 and column 326 lines 27-48 and Fig. 78),
- c) means for delivering the converted system to said client (column 318 lines 30-58 and column 326 lines 27-48 and Fig. 78).

As to claims 2 and 14, Ginter said client includes means for transmitting, to said roaming server, information on the intellectual property right protection system available for said client (Figs. 1, 2, 78-80).

As to claim 4, Ginter teaches said client includes means for transmitting, to the digital contents server, information on the intellectual property right protection system available for said client (Figs. 1, 2, 78-80).

As to claims 6 and 26, Ginter teaches said roaming server includes means for vicariously executing authentication between said client and said digital contents server (column 12 lines 31-38 and column 310 line 5 – column 311 line 29 and column 315 lines 42-58).

As to claims 23 and 34, Ginter teaches protection system information receiving means for receiving information on an intellectual property right protection system available for said client (Figs. 1, 2, 78-80).

As to claims 24 and 35, Ginter teaches said conversion means performs conversion processing on the basis of the information received by said protection system information receiving means (column 109 lines 43-49 and column 326 lines 27-48).

As to claims 43, 45, 47, 49 and 59, Ginter teaches the digital contents distribution methods are being program on program codes that are stored in a storage medium (Fig. 5B).

As to claims 50 and 58, Ginter teaches an information processing apparatus and method capable of being connected to an external device through a network, comprising (Figs. 1, 2, 78-80):

- a) transmission means for transmitting information on an intellectual property right protection system available for the apparatus and identification information for identification of said apparatus to the external device over said network (column 56 line 25-29 and Figs. 1, 2, 15A, 78-80);
- b) receiving means for receiving from the external device a digital content with the intellectual property right protection system protecting the digital content (column 56 lines 6-29 and Figs. 1, 2, 15A, 78-80).

#### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900.

As to claims 5 and 25, Ginter teaches the roaming server receives requests from the digital contents server, and the roaming server converts the intellectual property right protection system on the basis of the information (column 109 lines 43-49 and column 326 lines 27-48). Ginter does not specifically teach said roaming server receives information on a request for conversion of the intellectual property right protection system from the digital contents server. It would have been obvious to one of ordinary skill in the art to allow the requests received from the digital contents server by the roaming to be a request fro conversion of the intellectual property right protection system so that the digital contents servers can provided variety types of digital contents to the client.

8. Claims 7-10, 16-19, 27-30, 36-39, 51-53 and 55-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of Lewis et al., U. S. Patent 6,725,372.

As to claims 7, 16, 27, 36 and 51, Ginter teaches the digital content comprises digital data encoded in accordance with MPEG (column 250 line 59 – column 251 line 6 and column 326 lines 40-45). Ginter does not specifically teach the digital data encoded in accordance with MPEG-4. However, Lewis teaches encoding digital data in accordance with MPEG-4 (column 6 lines 15-46). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the digital data in Ginter's teaching to be encoded in accordance with MPEG-4 as taught by Lewis for

allowing the digital contents server dealing with various standards of MPEG for attracting more clients.

As to claims 8, 17, 28, 37 and 52, Ginter teaches the intellectual property right protection system comprises an IPMP System (column 57 lines 45-55; specifically, the "IPMP system" corresponds to the "rules and controls" in Ginter's teaching).

As to claims 9-10, 18-19, 29-30, 38-39 and 53, the claimed limitations are taught by Ginter as information is transmitted in and out the roaming server according to the "rules and controls" (column 57 lines 45-55).

As to claim 55, Ginter teaches transmitting to said external device the digital content with an intellectual property right protection system different from the intellectual property right protection system provided in said apparatus (column 109 lines 43-49 and column 326 lines 27-48 and Figs. 1, 2, 78-80).

As to claim 56, Ginter teaches transmits to said external device location information designating the location of the digital content (column 56 lines 25-29 and column 314 lines 1-23 and Figs. 1, 2).

As to claim 57, Ginter teaches the location information comprises URL (Uniform Resource Locator) information (column 314 lines 1-23 and Figs. 1, 2).

9. Claims 11-12, 20-21, 31-32, 40-41 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., U. S. Patent 5,892,900 in view of Lewis et al., U. S. Patent 6,725,372, and in further view of Fields et al., U. S. Patent 6,704,797.

As to claims 11-12, 20-21, 31-32, 40-41 and 54, Ginter modified by Lewis teaches digital contents distributing system as discussed above. Ginter modified by

Lewis does not specifically teach said client including means for transmitting IP\_address (Internet Protocol address) information for identification of said client or said apparatus and transmitting URL (Uniform Resource Locator) information for identification of the digital content. However, Fields teaches these matters (abstract and column 4 lines 15-33 and column 6 line 58 – column 7 line 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teaching of Ginter modified by Lewis to include the feature of transmitting IP\_address information for identification of said client and transmitting URL information for identification of the digital content as taught by Fields for preventing unauthorized access of the digital content.

### ***Conclusion***

10. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Pere (WO99/63420) discloses secure access to data in a network.

Wang (EP 1 113 617 A2) discloses transferring right to decode messages.

*Inquire*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 10:00 AM to 7:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final  
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung *Mary Cheung*  
Patent Examiner  
Art Unit 3621  
October 26, 2004